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EXAMINER

PARK, ILWOO

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 05/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,167

Applicant(s)

KAVANAUGH ET AL.

Examiner

Ilwoo Park

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 41-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 41-56 are presented for examination.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 41, 43, 45-48, 51-53, and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by May, US patent No. 5,043,721.

As to claim 41, May teaches a wallet [portable computing device 12: col. 1, lines 5-16] for use with a personal information device [paging accessory 10], the wallet comprising:

a first portion having an input device [keyboard 18 in fig. 1];

a second portion coupled to the first portion to receive, detachably retain, and interface with a personal information device [col. 2, lines 35-43]; and

a power source to provide electricity to the wallet, wherein the wallet conserves the power source by being turned on in response to a wake signal [col. 3, lines 62-68] from the personal information device.

4. As to claim 43, May teaches the personal information device comprises a personal digital assistant [col. 2, lines 58-66].

5. As to claim 45, May teaches the wallet turns off if it does not receive a stay awake signal from the wallet for a predetermined period of time [col. 3, lines 23-28].

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6. As to claims 46, 51, and 56, May teaches the power source comprises a battery [battery 65 in fig. 3].

7. As to claims 47 and 52, May teaches a method performed by a wallet [portable computing device 12: col. 1, lines 5-16] having a power source [fig. 3] and detachably retaining a personal information device [col. 2, lines 35-43], the method comprising:

receiving [col. 3, lines 62-68] a wake signal from the personal information device;  
and

turning [col. 2, lines 1-13] the wallet on in response to the wake signal by providing electricity to wallet components from the power source.

8. As to claims 48 and 53, May teaches turning the wallet off in response not receiving a stay awake signal from the personal information device for a predetermined period of time by powering down the wallet components [col. 3, lines 23-28].

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 42, 50, and 55 rejected under 35 U.S.C. 103(a) as being unpatentable over May as applied to claims 41, 47, and 52 above, and further in view of Steere, Jr. et al., US patent No. 5,848,298.

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As to claims 42, 50, and 55, May teaches the personal information device comprises a card [col. 2, lines 35-43]. However, May does not teach the card is in a form of a PCMCIA card.

Steere, Jr. et al teach [figs. 7-9; col. 1, lines 23-37] a wallet for use with a personal information device in a form of a PCMCIA card detachably retained in a second portion of the wallet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include Steere, Jr. et al's teaching of the personal information device being in a form of a PCMCIA card to increase adaptability of the plug-in card of May.

11. Claims 44, 49, and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over May as applied to claims 41, 47, and 52 above, and further in view of Ohtake et al., US patent No. 5,594,680.

As to claims 44, 49, and 54, May teaches the personal information device in a form of a plug-in card is connected to the wallet [host] to communicate signals including the wake signal from the personal information device to the wallet. However, May does not teach using an induction coil adapted to interface without electrical contact.

Ohtake et al teach a plug-in card is detachably connected to a host to communicate signals from the plug-in card to the host using an induction coil adapted to interface without electrical contact [col. 8, lines 1-5].

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to modify a connector [connector 16] of May into the Ohtake's

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teaching of an induction coil for communication without electrical contact in order to increase reliability of May's communication with the personal information device detachably connected.

### ***Response to Arguments***

12. Applicant's arguments filed 2/13/2004 have been fully considered but they are not persuasive.

The Applicant argues in substance that May does not teach the wallet a) as a flexible wallet, e.g., a leather wallet, and b) as a holding case for an electronics device that can provide additional functionality to a user operating the device using the wallet, and c) the paging accessory of May cannot teach the personal information device (PID) of claim 41 since PIDs are ordinarily understood and are described in the specification [pages 6-7] as organizers with various PDA and/or cellular telephone features.

For the point a), although the claims are interpreted in light of the specification, limitations, such as a "flexible" wallet or a "leather" wallet, from the specification are not read into the claims.

For the point b), May teaches the wallet [portable computing device 12 in fig. 1] as a holding case [col. 2, lines 40-43] for an electronics device [paging accessory 10 in fig. 1] that can provide additional functionality [col. 2, lines 3-13] to a user operating the device using the wallet.

For the point c), the specification does not describe the PID as organizers with various PDA and/or the specification does not describe the PID as organizers with cellular telephone features; the specification describes the PID provides various

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organizer or other types of features to a user and the specification also describes the PID is not to be limited to electronic organizers in pages 6-7. May teaches the PID [paging accessory 10 in fig. 1] providing other types of features [col. 2, lines 3-13] to a user

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ilwoo Park whose telephone number is (703) 308-7811. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Hand-delivered responses should be brought to US Patent and Trademark Office, 2011 South Clark Place, Customer Window, Crystal Plaza Two, Lobby, Room 1B03, Arlington, VA 22202.

A handwritten signature in cursive script, reading "Ilwoo Park".

Ilwoo Park

Primary Examiner

May 3, 2004